

REMARKS

Prior to entry of this Amendment, claims 10-12, 14-16, 18-20, 24, and 28-35 are pending in the application. Claims 10 and 20 are the independent claims under consideration.

In order to more particularly point out and distinctly claim the subject matter of the invention, Applicant hereby amends independent claims 10 and 20. No new matter has been introduced by these amendments, support therefor being found throughout the specification, for example, in paragraphs [0026] and [0028] and FIG. 2, as well as in these claims, as originally filed.

Claims 10-12, 14-16, 18-20, 24, and 28-35 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite. In view of the above amendments, reconsideration and withdrawal of this rejection are respectfully requested. Specifically, Applicant has amended independent claims 10 and 20 to clarify that the foamed sole (or midsole) element and the at least one support element comprise common polymer-based material (i.e., both elements are made from the same material, such as EVA, but are subjected to different process conditions and/or additives to exhibit different mechanical properties). See Specification, paragraph [0019].

Further, claims 10-12, 14-16, 18-20, 24, and 28-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ritter in view of Tanuma *et al.* ("Tanuma"). In view of the above amendments and following remarks, reconsideration and withdrawal of all grounds of rejection are respectfully requested.

As previously discussed, Ritter appears to disclose a sole having two distinct density materials that are hot compression molded together to form a structurally integral unit. See Ritter, col. 2, lines 46-49. A foot-shaped sole piece of desired size is made by die cutting the sole piece from a sheet of a thermoplastic or thermosetting compound of a desired hardness. See Ritter, col. 3, lines 10-12 and col. 4, line 30-33. A midfoot portion of a selected size and shape, corresponding to a desired shank portion, is then die cut out of the sole piece. See Ritter, col. 3, lines 13-14. The higher density shank portion is separately die cut to the same dimensions of the removed piece, and then inserted into the opening in the midfoot region of the sole piece. See Ritter, col. 3, lines 15-18. The composite is then hot compression molded together to integrally

fuse the shank portion to the rest of the sole, whereby chemical cross linking bonds are purportedly created between the shank and the remainder of the sole. See Ritter, col. 3, lines 18-22.

With respect to independent claim 10, Applicant has amended this claim to clarify that the sole for an article of footwear includes “the foamed sole element and the at least one support element comprising a common polymer-based material, the support element being harder than the foamed sole element and disposed below at least a portion of the foamed sole element, each of the foamed sole element and the support element forming at least a portion of one of the upper side and the lower surface of the sole,” and respectfully submits that Ritter and Tanuma do not teach or suggest a single-layer sole element having these components in the claimed configuration. For example, Ritter and Tanuma fail to disclose or suggest the two claimed elements that are both in overlapping relation and in exposed relation on at least one side of the sole.

With respect to independent claim 20, Applicant surprisingly notes that the Examiner has reconsidered his position, expressed during the August 24, 2004 interview, that amendments to claim 20 introduced in the Preliminary Amendment that accompanied the Request for Continued Examination render this claim allowable over the prior art of record. Turning to the Examiner’s apparent reliance on the second embodiment of Ritter’s sole disclosed in col. 5, line 34 through col. 6, line 44 and depicted in FIGS. 4-5, Applicant respectfully submits that, first, Ritter clearly discloses that top sole (72) is an element of the entire sole that is separate and distinct from the midsole (70). Conversely, Ritter does not teach or suggest that its midsole includes “a foamed midsole element and at least one support element comprising a common polymer-based material, the support element being harder than the foamed midsole element and disposed below at least a portion of the foamed midsole element,” as recited in claim 20.

In addition, Ritter is completely silent with respect to how its top sole (72) is attached to the midsole (70). Not surprisingly, Ritter does not teach or suggest at least that each of these parts of the sole exhibit “a different initial mechanical property” and that these parts are “attached by co-vulcanization” such that “after attachment, at least one of [these parts of the sole] exhibits a change in the initial mechanical property.”

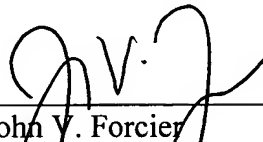
For at least these reasons, Applicant respectfully submits that independent claims 10 and 20, as amended, are allowable over the art of record. Because claims 11-12, 14-16, 18-19, 24, and 28-35, depend either directly or indirectly, from either amended independent claim 10 or 20, Applicant respectfully submits that these claims are allowable as well. Reconsideration and withdrawal of all grounds of rejection are respectfully requested.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration, withdrawal of all grounds of rejection, and allowance of claims 10-12, 14-16, 18-20, 24, and 28-35 in due course. The Examiner is invited to contact Applicant's undersigned representative by telephone at the number listed below to discuss any outstanding issues.

Respectfully submitted,

Date: January 18, 2005
Reg. No. 42,545
Tel. No. (617) 248-7453
Fax No. (617) 248-7100



John V. Forcier
Attorney for Applicant
Testa, Hurwitz, & Thibault, LLP
125 High Street
Boston, MA 02110

3166083